

REMARKS

The Office Action dated October 29, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

STATUS OF THE CLAIMS

Claims 1-9, 12-29, 31-46, and 64-67 are currently pending in the application, of which claims 1, 22, 38, and 64-65 are independent claims, and claims 47-48 and 50-58 were withdrawn from consideration. Claims 1-9, 12-29, 31-48, and 50-58 have been amended, and claims 64-67 were added, to more particularly point and distinctly claim the subject matter of the present invention. No new matter has been added. Claims 10-11, 30, 49, and 59-63 have been cancelled without prejudice or disclaimer. Claims 1-9, 12-29, 31-48, 50-58, and 64-67 are respectfully submitted for consideration.

ALLOWABLE SUBJECT MATTER

Claims 31 and 42 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for this indication of allowable subject matter. Applicants respectfully submit that the claims from which claims 31 and 42 depend are also allowable, as discussed below. Thus, it is respectfully requested that the objection to claims 31 and 42 be withdrawn.

ELECTION/RESTRICTION

Claims 47-63 were withdrawn from consideration as allegedly being directed to a non-elected invention. Applicants respectfully traverse the restriction of claims 47-48 and 50-58. Claims 49 and 59-63 have been cancelled without prejudice or disclaimer.

The Office Action asserted that the restriction of claims 47-63 is proper because “a terminal device by itself is a complete separate entity” (*see* Office Action at page 2, item 1). The Office Action continued, “Even though the terminal device’s functionality is related to call response server for providing voice mail service, by itself is classified in a different class and subclass category” (*see* Office Action at page 2, item 1). This is an incorrect application of the rules. MPEP 803 states, “the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if ... they are either independent ... or distinct” MPEP 802.01(II) states, “Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (*e.g.*, can be made by, or used in, a materially different process)” MPEP 803 also states: “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”

As discussed above, the Office Action admitted that the terminal device is related to the call response server, but asserted that the terminal device is distinct because it is a complete separate entity and is classified in a different class and subclass category. This is incorrect because the terminal device is connected to the call response server in design,

operation, and effect. For example, the terminal device includes “a processor configured to prepare a programming media message to program an automatic call response server,” as recited in claim 47. Furthermore, examination of all the claims together does not present a serious burden to the Examiner since many of the features of claims 47-48 and 50-58 have already been examined in claims 1-9, 12-29, 31-46. For example, claim 1 recites “receiving in a response server a media message from a terminal, the media message comprising ... application specific content ... to program ... the response server.” Thus, Applicants respectfully submit that the restriction of claims 47-48 and 50-58 is improper, and respectfully request that the restriction of claims 47-48 and 50-58 be withdrawn.

Consideration and allowance of claims 47-48 and 50-58 are therefore respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 112

Claim 13 was rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Office Action asserted that the phrase “information i” was not defined in the dependent claims nor in the specification. Claim 13 has been amended to remove the letter “i.” Accordingly, Applicants respectfully submit that this rejection is moot in view of this amendment, and respectfully request that this rejection be withdrawn.

Reconsideration and allowance of claim 13 are thus respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 102

Claims 1-3, 5-30, 32-41, and 43-46 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent Appln. Pub. No. 2005/0020250 of Chaddha et al. (“Chaddha”). Applicants respectfully submit that each of claims 1-3, 5-9, 12-29, 32-41, and 43-46 recites subject matter which is neither disclosed nor suggested in Chaddha. Claims 10-11 and 30 have been cancelled without prejudice or disclaimer.

Independent claim 1, upon which claims 2-9 and 12-21 depend, is directed to a method including receiving in a response server a media message from a terminal, the media message including response content and application specific content. The method also includes using the application specific content to program a call response of the response server.

Independent claims 22, upon which claims 23-29 and 31-37 depend, is directed to an apparatus including a receiver configured to receive a media message which includes response content and application specific content. The apparatus also includes a processor configured to store the response content, and to use the application specific content to program a call response of the apparatus.

Independent claim 38, upon which claims 39-46 depend, is directed to an apparatus including a receiver configured to receive, from a terminal, a media message which includes response content and application specific content. The apparatus also includes a processor configured to process the media message to derive the response

content, to store the derived response content of the media message, and to process the application specific content.

Based on its actual filing date, Chaddha (filed May 24, 2004) is not prior art with respect to the present application since it was filed after April 5, 2004, which is the filing date of the present application. Applicants note that Chaddha's priority (not actual) filing date would appear to be May 23, 2003, based on its relationship to U.S. Provisional Patent Appln. No. 60/472,989 (the '989 application), U.S. Provisional Patent Appln. No. 60/472,990 (the '990 application), and U.S. Provisional Patent Appln. No. 60/472,994 (the '994 application). Alternatively, Chaddha's effective filing date would appear to be October 9, 2003, based on its relationship to U.S. Provisional Patent Appln. No. 60/510,214 (the '214 application), or November 13, 2003, based on its relationship to U.S. Provisional Patent Appln. No. 60/520,471 (the '471 application). Applicants note, however, that the '989 application, the '990 application, the '994 application, the '214 application, and the '471 application (the related provisional applications) are quite different, at least in form, from Chaddha. Accordingly, for at least these reasons, it is respectfully requested that the rejection of claims 1-3, 5-9, 12-29, 32-41, and 43-46 be withdrawn as based on a reference that is not prior art under 35 U.S.C. 102(e) or any other statutory section. If the rejection is maintained based on the disclosure of the related provisional applications, it is respectfully submitted that a *prima facie* rejection must substantiate the rejection with reference to those disclosures, by page and line number of those documents.

Nevertheless, for the Examiner's convenience, the following discussion of the cited art is provided.

Applicants respectfully submit that Chaddha fails to disclose or suggest all of the features of any of the presently pending claims.

Chaddha refers to a method and a system for forwarding information such as data files to a recipient across disparate or incompatible communication networks, which are not constrained by incompatible user devices. The sender sends information such as a data file to an intended recipient via a messaging server. The messaging server communicates with the intended recipient using communication tools that are generally compatible regardless of the network that the recipient is subscribed to. The messaging server stores the information, creates and sends a notification message to the intended recipient that she has information to be retrieved. The notification message includes a unique access address associated with the message, at which the recipient can retrieve the information (*see* Chaddha at Abstract).

However, Chaddha does not disclose or suggest, at least, "the media message comprising response content and application specific content ... and using the application specific content to program a call response of the response server," as recited in independent claim 1 and similarly recited in independent claims 22 and 38. As discussed above, Chaddha refers to a data file and a messaging server receiving and storing the data file (*see also* Chaddha at Figure 2 and paragraph 0028). However, Chaddha fails to disclose or suggest that the data file includes response content and application specific

content used to program a call response of a response server. Accordingly, Chaddha does not disclose or suggest, at least, “the media message comprising response content and application specific content ... and using the application specific content to program a call response of the response server,” as recited in independent claim 1 and similarly recited in independent claims 22 and 38.

For at least the reasons discussed above, Applicants respectfully submit that Chaddha fails to disclose or suggest all of the elements of independent claims 1, 22, and 38. Accordingly, Applicants respectfully request that the rejection of independent claims 1, 22, and 38 be withdrawn.

Claims 2-3, 5-9, 12-21, 23-29, 32-37, 39-41, and 43-46 depend respectively from, and further limit, claims 1, 22, and 38. Thus, each of claims 2-3, 5-9, 12-21, 23-29, 32-37, 39-41, and 43-46 recite subject matter that is neither disclosed nor suggested in Chaddha. It is, therefore, respectfully requested that the rejections of claims 2-3, 5-9, 12-21, 23-29, 32-37, 39-41, and 43-46 be withdrawn.

Reconsideration and allowance of claims 1-3, 5-9, 12-29, 32-41, and 43-46 are therefore respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 103

Claim 4 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Chaddha in view of Official Notice as to what was allegedly “known in the art.” The Office Action took the position that Chaddha discloses all of the elements of the claims,

with the exception of the features recited in claim 4. The Office Action the relies upon Official Notice as allegedly curing these deficiencies in Chaddha. Applicants respectfully submit that claim 4 recites subject matter which is neither disclosed nor suggested in the combination of Chaddha and Official Notice.

In order for this rejection to be sustainable, the combination of Chaddha and Official Notice must teach all the recitations of independent claim 1. Accordingly, the arguments presented above supporting the patentability of independent claim 1 over Chaddha are incorporated herein to support the patentability of dependent claim 4. Thus, it is respectfully requested that dependent claim 4 be allowed. Official Notice fails to cure the deficiencies of Chaddha.

Official Notice was taken that using a Session Initiation Protocol (SIP) message was old and well known in the art of messaging (*see* Office Action at page 13). However, Official Notice does not cure the deficiencies of Chaddha. Similarly to Chaddha, Official Notice fails to disclose or suggest, at least, “the media message comprising response content and application specific content ... and using the application specific content to program a call response of the response server,” as recited in independent claim 1. Official Notice is silent as to teaching the particular features associated with the media message of independent claim 1.

Thus, the combination of Chaddha and Official Notice would not lead a person of ordinary skill in the art to arrive at the features of the media message as recited in independent claim 1. Consequently, Applicants respectfully submit that independent

claim 1 and related dependent claim 4 are not obvious over the combination of Chaddha and Official Notice. Accordingly, Applicants respectfully request that the rejection of claim 4 be withdrawn.

Reconsideration and allowance of claim 4 are respectfully submitted.

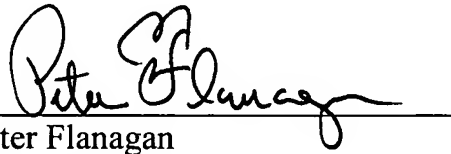
CONCLUSION

For the reasons explained above, it is respectfully submitted that each of claims 1-9, 12-29, 31-48, 50-58, and 64-67 recite subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-9, 12-29, 31-48, 50-58, and 64-67 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", written over a horizontal line.

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Enclosures: Additional Claim Fee Transmittal
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